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EXAMINER

CAMPEN, KELLY SCAGGS

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3624

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/443,038

Filing Date: November 18, 1999

Appellant(s): MCCROSSIN ET AL.

Shawn W. O'Dowd
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 04, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3, 7,9-10, 14-19 and 23-24.

Claims 4-6, 8, 11-13, 20-22, 25-43 are withdrawn from consideration as not directed to the elected invention and species.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3,7,9,10,14-19,23 and 24 may be grouped together for the purpose of this appeal. For examination purposes, this statement is being taken to mean that the instant claims stand or fall together.

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,032,989

Tornetta

7-1991

Bonnaure et al. WO 98/04088 1-1998

Ye "A Proposal For A Geographic-Based Address Structure For IPv6" Masters Thesis, DalTech, Dalhousie University, Halifax, Nova Scotia, 1998.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7, 9,10, 14-19, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 , 6 and 17, the limitation "each of said first web-sites being identified by a physical location" is indefinite. A web site does not exist in the physical sense and so it is confusing to suggest that a web site can be identified by a physical location. Does this claim language intend to limit the claim to web sites (and the information stored therein) that exist at a physical location or to web sites (and the information stored therein) that are in some way identifiably associated with a geographical region or locale? This language causes confusion as to the metes and bounds of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 7, 9 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnaure et al. (WO 98/04088) in view of Ye (Masters Thesis, as cited above, 1998).

As per Claim 1, Bonnaure et al discloses a method of providing information to a user (page 19, lines 19-22) comprising:

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- o Collecting information at a first computer system (page 12, lines 13-29).
- o Organizing the information into a plurality of first web sites (page 7, lines 18-33).
- o Bonnaure et al teaches that each of the first web sites are accessible by a network address associated with the client's geographical location (page 18, lines 24-30), but does not explicitly state that the network address is a unique Universal Resource Locator (URL) having a physical location associated therewith as claimed by the applicant. Ye teaches a geographic-based URL address structure (Chapter 2, pages 11-22). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Bonnaure et al with the geographic-based URL taught by Ye to arrive at the invention as claimed by the applicant. The advantages are to enable the creation of location dependent services (Ye, page 8, section 1.4, lines 5-6).
- o Providing one of the first web-sites to a user as a user web-site (page 6, lines 2432); and
- o Selecting links to a plurality of first web sites for presentation on the user web site based on a relationship between the physical locations associated with the first web sites and the physical location associated with the user web-site (page 20, lines 1723).

As per Claim 2, Bonnaure et al explicitly disclose that the users access the user web site (Figure 11, block 1112).

As per Claim 3, Bonnaure et al explicitly discloses that his system is able to ascertain the geographic locality of the user's web site (page 19, lines 9-10), but does not explicitly state that the user web site is the physical location of a computer system of the user as claimed by the applicant. Ye teaches that his geographic-based address structure can be use to pin point the location of the user's computer down to one centimeter resolution (page 70, section 5.6, second

paragraph, lines 1-2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Bonnaure et al with the ability to locate the physical location of the user's computer as taught by Ye for the advantage of enabling the creation of location dependent services around the actual user location.

Bonnaure et al explicitly teaches that the physical location associated with the user web site by the user is specified by the user (page 18, paragraph 3, lines 2-3).

Bonnaure et al expressly states that the physical location associated with the user web site is based on a current telephone number at which the user is located (page 18, paragraph 3, lines 6-8).

Bonnaure et al teaches a method where the telephone number used to connect to the network system (page 18, paragraph 3, lines-9-15), determines the physical location of a user. Bonnaure et al also teaches that the user specifies the physical location at a first time (page 8, second paragraph, lines 1-3). In order for a physical location based addressing scheme to effective, the addressing scheme would inherently have a way to update the physical location of the user as the user's location changes. Bonnaure et al does not expressly state that the user's location is modified by the user a second time as claimed by the applicant. Ye, however, teaches the use of a Global Positioning System (GPS) to update the physical location of the network user (Abstract, paragraph 3). GPS systems inherently provide continuous (including the second time) modification of the physical location of a user. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Bonnaure et al with the ability to modify the location of the network user a second time as taught by Ye for the advantage of supporting the mobility of network users.

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As per Claim 7, Bonnaure et al explicitly discloses that the user's computer system is coupled to the first computer system via the Internet (Figure 7).

Bonnaure et al expressly discloses that the user's computer system is coupled to the Internet via a telephone connection and the physical location is based on a location of the telephone connection (page 18, last paragraph).

As per Claim 9, Bonnaure et al teaches defining a local area relative to the physical Location associated with the user's web-site such that the physical locations associated with the selected Links to the plurality of first web-sites is in the local area (page 19, second paragraph). Claim 16 contains Limitations already covered in the rejections of Claims 1 and 2, so the same rejections apply to the rejection of this Claim.

Claim 17 is a system claim containing limitations already covered in the rejection of Claim 1 above, so the same rejection applies to the rejection of this Claim.

Claim 18 is a system claim containing imitations already covered in the rejection of claim 9 above, so the same rejection applies to the rejection of this Claim.

Claims 10,14, 15, 19, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnaure et al. and Ye as applied to claims 1 and 9 above, and further in view of Tornetta (US Patent No. 5,032,989).

As per Claims 10 and 19, it has been established in the rejection of previous claims that Bonnaure et al and Ye teach a method for providing information and services to users of a network where the web-site used in the network are associated with a physical location and the information and services are available to users with in a local area of a user's web-site. Bonnaure et al and Ye do not explicitly state that the local area is a circular area having a predetermined

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radius from the physical location associated with the user's web site. Tornetta discloses a real estate search and location network where the user specified Local area is a circular area having a predetermined radius from the physical location associated with the user's web site (column 9, lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Bonnaure et al and Ye with the ability to select a circular area having a predetermined radius from a physical location as taught by Tornetta for the advantage of permitting the user to specify the precise location and local area of interest (Tornetta, column 9, lines 24-27).

As per Claims 14 and 23, it has already been established that the combined teachings of Bonnaure et al, Ye and Tornetta allow the user to graphically establish a circular local area around a specific geographical location. Tornetta goes on to teach that the local area can include a threshold amount of entries (column 9, line 66 through column 10, line 21). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Bonnaure et al and Ye with the ability to establish a threshold amount as taught by Tornetta for the advantage of limiting the local area to those entities the meet the desired parameters.

As per Claims 15 and 24, Bonnaure et al explicitly teaches that a geographical region can be defined to specific defined sub-region based upon the phone number connection locations as claimed by the applicant (page 18, paragraph 3).

(11) Response to Argument

In response to applicant's arguments to the 35 USC 112 second paragraph rejection, applicant points out specific sections of the specification but refuses to amend the claim

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accordingly. The arguments are not specific (“may be” language in applicant’s definitions of the terms) but applicant is asking for something quite specific. It is unclear whether the language is directed to a geographical location or a physical location as these locations may or may not be as defined by applicants own definitions, which include the phrase “may ...” which includes the possibility that it may not be.

In response to applicant's arguments against the 35 USC 103 rejection, there is no support to be found for the legal conclusions. After reading the arguments, it is my conclusion that Bonnaure together with Ye clearly provide applicants invention of claims 1-3, 7, 9, 16-18, and further with Tornetta for claims 10, 14-15, 19, 23 and 24. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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January 23, 2005

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